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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/251,100	10/13/97	PRICE	IOWA-0127FUS

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HM21/0813

EXAMINER
SMITH, L.

ART UNIT	PAPER NUMBER
1648	

DATE MAILED: 08/13/98

Please find below and/or attached an Office communication concerning this application or proceeding.

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# Office Action Summary

Application No.  
**08/951,188**

Applicant(s)

Price

Examiner  
**Lynette R. F. Smith**

Group Art Unit  
**1648**



☐ Responsive to communication(s) filed on \_\_\_\_\_

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire one month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-67 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☐ Claim(s) \_\_\_\_\_ is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☒ Claims 1-67 are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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## **DETAILED ACTION**

### ***Election/Restriction***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-32, drawn to DNA, host cells and expression vectors, classified in class 536, subclass 23.1.
  - II. Claims 36-39, 41, drawn to protein composition and antibody, classified in class 530, subclass 350.
  - III. Claim 40, drawn to an enzyme subunit, classified in class 530, subclass 300.
  - IV. Claims 33, 34, drawn to method of detecting DNA in a sample, classified in class 435, subclass 6.
  - V. Claim 35, drawn to method of expressing DNA, classified in class 435, subclass 69.1.
  - VI. Claim 42, drawn to method of identifying a gene, classified in class 435, subclass 69.3.
  - VII. Claims 43-47, drawn to method for identifying a transcriptional inhibitor, classified in class 435, subclass 69.2.
  - VIII. Claim 48, drawn to method for identifying Tat protein, classified in class 435, subclass 7.1.

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IX. Claims 49-58, drawn to method of identifying viral transcription inhibitor, classified in class 935, subclass 76.

X. Claims 59-67, drawn to another method of identifying a viral transcription inhibitor, classified in class 935, subclass 77.

2. The inventions are distinct, each from the other because of the following reasons:

Inventions I, II and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together, or they have different modes of operation, or they have different functions, or they have different effects. (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are being view as different products which have different structures and functions and are therefore unobvious and patentably distinct each over the other .

3. Inventions IV, V, VI, VII, VIII, IX and X are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together, or they have different modes of operation, or they have different functions, or they have different effects. (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions the inventions are being viewed as different methods which have different steps and procedures and are therefore unobvious and patentably distinct each over the other.

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, divergent subject matter and

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the examination of all groups would constitute a serious burden on the examiner, restriction for examination purposes as indicated is proper.

5. This application contains claims directed to the following patentably distinct species of the claimed invention: the species appear in group I:

a.) Full length DNA and corresponding seq. I.D. No.

b.) Full length DNA and full length kinase subunit and corresponding seq. I.D. No.

If species b is elected, then a further election is required

1) single expression vector or

2) two distinct expression vectors. The species are being viewed as two distinct products which are unobvious and patentably distinct each over the other.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claim is generic.

6. Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

7. Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations

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of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

8. **Please Note:** In an effort to enhance communication with our customers and reduce processing time, Group 1640 is running a Fax Response Pilot for Written Restriction Requirements. A dedicated Fax machine is in place to receive your responses. The Fax number is 703-305-3704. A fax cover sheet is attached to this Office action for your convenience. We encourage your participation in this Pilot program. If you have any questions or suggestions please contact Donald E. Adams, Ph.D., supervisory Patent Examiner at Donald.Adams@uspto.gov or 703-308-0570. Thank you in advance for allowing us to enhance our customer service. Please limit the use of this dedicated Fax number to responses to Written Restrictions.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Lynette F. Smith whose telephone number is (703) 308-3909.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Donald E. Adams, can be reached on (703) 308-0570.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

SMITH/lfs *lfs*  
August 12, 1998

*L. F. Smith*  
LYNETTE F. SMITH  
PRIMARY EXAMINER  
GROUP 1800



# RESTRICTION ELECTION FACSIMILE TRANSMISSION

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